

ESTTA Tracking number: **ESTTA219739**

Filing date: **06/23/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92049364
Party	Defendant Floyd's 99 Holdings, LLC
Correspondence Address	Karen O'Brien Floyd's 99 Holdings, LLC 5340 S. Quebec St., Suite 205N Greenwood, CO 80111 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Jeffrey J. Cowman
Filer's e-mail	lheersink@perkinscoie.com
Signature	/Jeffrey J. Cowman/
Date	06/23/2008
Attachments	2008 0623 Mtn to suspend cancellation proceeding.pdf (4 pages)(16015 bytes) Exhibit A.pdf (8 pages)(240827 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Shawn W. Woodrum, a Colorado Resident,)	
d.b.a Floyd's Barber Shop, a Colorado Sole)	Cancellation No.: 92049364
Proprietorship)	
)	Registration No.: 2,749,894
Petitioner,)	Registration Date: August 12, 2003
v.)	
)	Registration No.: 3,063,720
Floyd's 99 Holdings, LLC,)	Registration Date: February 28, 2006
a Colorado limited liability company)	
)	
Respondent.)	
)	

MOTION TO SUSPEND CANCELLATION PROCEEDING
PENDING RESOLUTION OF PARALLEL FEDERAL DISTRICT
COURT ACTION

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P. O. Box 1451
Alexandria, VA 22313-1451

Respondent Floyd's 99 Holdings, LLC ("Floyd's 99"), through counsel Perkins Coie LLP, moves to suspend this cancellation proceeding pending the outcome of a parallel District Court action pursuant to 37 CFR § 2.117 and Rule 510.02 of the Trademark Trial and Appeal Board Manual of Procedure. In support of this motion, Floyd's 99 states as follows:

Floyd's 99 filed on June 20, 2008 a Complaint for Declaratory Judgment in the United States District Court for the District of Colorado captioned as *Floyd's 99 Holdings, LLC v. Shawn W. Woodrum*, Civil Action No. 08-cv-01321-MSK-BNB ("District Court action"). The District Court action encompasses the same issues as are before the Board in this cancellation proceeding and other related claims. Specifically, Floyd's 99 has requested that the Court judicially declare that its federally registered trademarks, including the trademarks "Floyd's 99"

and “Barbershops For Men & Women Floyd’s 99 Old School. New Styles.” and Design do not cause a likelihood of confusion with or otherwise infringe upon Petitioner’s use of the name Floyd’s Barber Shop in a trade area remote to Respondent’s businesses; that Petitioner is barred by the doctrine of laches from enforcing against Respondent any right which Petitioner may claim to the names Floyd’s, Floyd’s 99 or other derivations thereof; and, in the alternative, that the Court judicially declare that Respondent may concurrently use the name and trademark “Floyd’s 99” and other trademarks with Petitioner’s use of the name Floyd’s Barber Shop and that Petitioner’s use of that name be restricted to Buena Vista, Colorado, the sole trade area in which Petitioner has used that name for a period which he alleges to be in excess of nine years. Respondent attaches to this motion as Exhibit A the Complaint for Declaratory Judgment filed in the District Court action.

The TTAB Manual of Procedure recognizes that the pendency of a parallel federal court action is a common and appropriate basis for suspending a TTAB proceeding:

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action.

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a Federal district court. To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is often binding upon the Board, while the decision of the Board is not binding upon the Court.

Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceedings will have a bearing on the issues before the Board.

TBMP § 510.02(a) (footnotes omitted).

The District Court action clearly has “issues in common” with this proceeding. As set forth more specifically in the Complaint for Declaratory Judgment, Respondent is seeking relief in that action in the form of a declaration that its use of the names and trademarks “Floyd’s 99” and “Barbershops For Men & Women Floyd’s 99 Old School. New Styles.” and Design are not confusingly similar with Petitioner’s use of the name Floyd’s Barber Shop and that there is an insufficient basis upon which to terminate Respondent’s registrations. Further, Respondent seeks, in the alternative, a judicial declaration that it may use the names and trademarks “Floyd’s 99” and “Barbershops For Men & Women Floyd’s 99 Old School. New Styles.” and Design concurrent with Petitioner’s use of the name Floyd’s Barber Shop, subject to specific geographic restrictions.

The final determination of the District Court action will not have merely a bearing upon this cancellation proceeding, but will fully determine its outcome. In addition, the District Court action will also resolve other issues that are related to, but have not yet been raised in this proceeding, including the applicability of the doctrine of laches to the relief sought by Petitioner and the concurrent use of the parties’ respective names and trademarks.

WHEREFORE, Respondent Floyd’s 99 Holdings, LLC requests that the Board grant this motion and suspend this proceeding until final resolution of the pending parallel District Court action and that the Board direct such further process as it deems necessary.

PERKINS COIE LLP

By: s/Jeffrey J. Cowman/
Jeffrey J. Cowman
1899 Wynkoop Street, Suite 700
Denver, CO 80202-1043
Telephone: 303.291.2300
Facsimile: 303.291.2400
Email: JCowman@perkinscoie.com
Attorneys for Respondent Floyd’s 99 Holdings, LLC

CERTIFICATE OF MAILING

I hereby certify that this MOTION TO SUSPEND CANCELLATION PROCEEDING PENDING RESOLUTION OF PARALLEL FEDERAL DISTRICT COURT ACTION, is being deposited with the United States Postal Service with sufficient postage as first class mail on June 23, 2008 in an envelope addressed to Petitioner: Shawn W. Woodrum, dba Floyd's Barber Shop, 116 North Court Street, P. O. Box 1549, Buena Vista, CO 81211-1549.

Signature: Jeffrey J. Cowman/

Printed Name: Jeffrey J. Cowman

JUN 26 2008

GREGORY C. LANGHAM
CLERK

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF COLORADO

Civil Action No. _____

'08 - CV - 01321 - msk - BNB

FLOYD'S 99 HOLDINGS, LLC, a Colorado limited liability company

Plaintiff,

v.

SHAWN W. WOODRUM,

Defendant.

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff Floyd's 99 Holdings, LLC ("Floyd's 99") through undersigned counsel, for its Complaint for Declaratory Judgment against Defendant Shawn W. Woodrum ("Woodrum"), states and alleges as follows:

I. NATURE OF THE CASE

1. This case arises from Defendant's assertion that Plaintiff's use of its federally registered trademarks "Floyd's 99" and "Barbershops For Men & Women Floyd's 99 Old School. New Styles." and Design (collectively the "Floyd's 99 Marks") creates a likelihood of confusion among consumers with Defendant's use of the name "Floyd's Barber Shop." On that basis, Defendant has petitioned the United States Patent and Trademark Office ("USPTO") to cancel Plaintiff's Floyd's 99 Marks.

2. Plaintiff seeks a judicial declaration that its use of its federally registered Floyd's 99 Marks is not likely to cause confusion among consumers in the relevant trade areas where the parties conduct business or where it is reasonably probable they will expand. Further, Defendant

has delayed unreasonably in his assertion of his claim that the parties' respective names and marks are confusingly similar and therefore, said claim is equitably barred. In the alternative, Plaintiff seeks a judicial declaration that Plaintiff may use the Floyd's 99 Marks concurrently with Defendant's use of Floyd's Barber Shop subject to the geographic restrictions more specifically described herein.

II. PARTIES

3. Plaintiff is a Colorado limited liability company with its principal place of business at 5340 S. Quebec, Suite 205N, Greenwood Village, Colorado 80111.

4. Upon information and belief, Defendant is a Colorado resident doing business as Floyd's Barber Shop at 116 North Court Street, Buena Vista, Colorado 81211.

III. JURISDICTION

5. This is an action seeking a declaratory judgment determining the rights of the parties to use the names and marks "Floyd's 99" and "Barbershops For Men & Women Floyd's 99 Old School. New Styles." and Design, on the one hand and Floyd's Barber Shop on the other and the geographic areas within which the use of such names and marks is allowed. The Court has jurisdiction pursuant 28 U.S.C. §§ 2201 and 2202, 28 U.S.C. § 1331 and 28 U.S.C. § 1338(a).

IV. VENUE

6. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) and (c) because Defendant is subject to personal jurisdiction in this district and a substantial part of the events or omissions giving rise to the relief sought herein occurred in this district.

V. GENERAL ALLEGATIONS

7. In 1998, the founders and current owners of the Floyd's 99 Marks determined to use the name "Floyd's" in conjunction with the development and operation of retail hair care businesses providing a broad scope of services to men, women and children, including stylish, professional haircuts for a reasonable price in an atmosphere that can be described as the "hip" modern version of a traditional walk-in service barbershop. At that time, a design professional was hired to develop a logo to be used in conjunction with the name "Floyd's".

8. In January 1999, Plaintiff received from the designer the logo "Barbershops For Men & Women Floyd's 99 Old School. New Styles." and Design (the "Logo").

9. By July 2000, Plaintiff was using the "Floyd's 99" name and mark and the Logo in public advertising campaigns.

10. On February 13, 2001, Floyd's 99, Inc. was incorporated in the State of Colorado.

11. By no later than February, 2001, Floyd's 99, Inc., the predecessor to Plaintiff, began to use the names and marks "Floyd's 99" and the Logo in the conduct of business at its shop located in Denver, Colorado.

12. Subsequent to Plaintiff's use of the Floyd's 99 Marks in interstate commerce, Defendant contacted Plaintiff and claimed he was conducting a small business in Buena Vista, Colorado using the name "Floyd's Barber Shop."

13. Plaintiff's representatives subsequently observed Defendant's business and found it to be of a very small scale and substantially different in nature and kind from Plaintiff's businesses that at the time were located more than 120 miles from Defendant's business.

14. On August 5, 2002, Floyd's 99, Inc. filed for a federal registration of its Logo "Barbershops for Men & Women Floyd's 99 Old School. New Styles." and Design and that

registration was issued by the USPTO effective August 12, 2003 as evidenced by Registration No. 2,749,894. A copy of that registration and records of the Assignment Division of the USPTO are attached hereto as Exhibit 1.

15. At the time of the filing for that registration, Plaintiff did not believe its name and business was confusingly similar to Defendant's name and business based, in part, on the substantial differences in their respective marks, the nature and conduct of their businesses and their remote location to each other which caused them to have distinct and different trade areas.

16. On March 18, 2005, Plaintiff filed for a federal registration of the word "Floyd's 99" and that registration was issued by the USPTO effective February 28, 2006 as evidenced by Registration No. 3,063,720. A copy of that registration is attached hereto as Exhibit 2.

17. Since 2001, Plaintiff has continuously and prominently used the name and mark, "Floyd's 99," and the Logo as symbols of its products and services.

18. The USPTO has recognized that as a result of Plaintiff's exclusive use of its "Floyd's 99" and Logo trademarks for its products and services, Plaintiff has protectable and enforceable trademark rights in the Floyd's 99 Marks as evidenced by its registrations attached hereto.

19. Plaintiff has expended substantial money to promote, advertise and expand its "Floyd's 99" business and in furtherance of same, plans to continue to expand substantially throughout the United States and internationally.

20. As a result of Plaintiff's substantial expansion of its business in connection with the Floyd's 99 Marks, it has become well known to consumers throughout the United States and internationally.

21. Since 2001, Plaintiff, its subsidiaries and franchisees have substantially expanded its business in association with the names and marks Floyd's 99 and the Logo to include 16 subsidiary-owned and 10 franchised locations in 5 states and 2 countries.

22. During that same time, Defendant has not expanded its Floyd's Barber Shop business and its business remains limited to a single location in Buena Vista, Colorado.

23. Despite Defendant's failure to expand his business in any material respect for more than nine years, he has frivolously claimed there is a likelihood of confusion arising from the "natural progression and expansion" of his business in Colorado, nationally and internationally.

24. Defendant claims he is likely to be damaged by Plaintiff's registrations and continued use of the Floyd's 99 Marks despite the substantial differences that exist between Plaintiff's businesses and Defendant's business and despite the fact that Plaintiff's businesses are located a substantial distance from Defendant's business.

25. On the basis of such unfounded allegations, Defendant has sought to cancel Plaintiff's federal trademark registration of "Floyd's 99" and the Logo and to otherwise restrict Plaintiff's use of its federally registered trademarks.

FIRST CLAIM FOR RELIEF

26. Plaintiff incorporates the allegations set forth in Paragraphs 1 through 25 as if fully set forth herein.

27. A justiciable case or controversy exists between the parties as to whether Plaintiff's use of the Floyd's 99 Marks, in the context of its businesses and relevant trade area, is likely to cause confusion among consumers or otherwise infringe upon Defendant's use of the name Floyd's Barber Shop in Defendant's relevant trade area.

28. Plaintiff's use of the Floyd's 99 Marks has not created confusion for any customers or potential customers and is not likely to cause any likelihood of confusion so as to warrant the cancellation of Plaintiff's federally registered trademarks or to otherwise restrict Plaintiff's use of the Floyd's 99 Marks.

SECOND CLAIM FOR RELIEF

29. Plaintiff incorporates the allegations set forth in Paragraphs 1 through 28 as if fully set forth herein.

30. Defendant had actual knowledge of Plaintiff's use of the Floyd's 99 Marks by no later than May 2001.

31. Defendant knew or should have known of Plaintiff's continued use of the Floyd's 99 Marks thereafter and Plaintiff's substantial expenditures to support and expand its use of the Floyd's 99 Marks nationally and internationally.

32. Defendant unreasonably delayed more than seven years before taking formal action to demand that Plaintiff cease to use the Floyd's 99 Marks and to seek to cancel Plaintiff's Floyd's 99 Marks.

33. Plaintiff has been substantially prejudiced by Defendant's unreasonable delay in seeking to enforce his alleged rights.

34. Defendant is barred by the doctrine of laches from enforcing against Plaintiff any right which Defendant may claim to the names Floyd's or Floyd's 99 or other derivations thereof.

THIRD CLAIM FOR RELIEF

35. Plaintiff incorporates the allegations set forth in Paragraphs 1 through 34 as if fully set forth herein.

36. Plaintiff adopted the use of the Floyd's 99 Marks in good faith.

37. Since its adoption and first use of the Floyd's 99 Marks, Plaintiff has invested substantial sums and expanded significantly its use of the Marks nationally and internationally.

38. During that same period, Defendant has not expanded his business to any other location or otherwise expanded his use of the name Floyd's Barber Shop.

39. To the extent that the Floyd's 99 Marks and Floyd's Barber Shop are deemed to cause a likelihood of confusion among consumers in Plaintiff's and Defendant's relative trade areas, which Plaintiff specifically denies, Plaintiff and Defendant should be allowed concurrent use of their respective names and marks.

40. As part of that concurrent use, Defendant's use should be restricted to Buena Vista, Colorado because Defendant has, through his inaction over allegedly more than nine years, abandoned his right to use the name and mark outside of that immediate trade area.

41. Consistent with Plaintiff's historical and substantial expansion of its use of the Floyd's 99 Marks, it should be granted the exclusive right to use its Floyd's 99 Mark in all other trade areas other than Buena Vista, Colorado.

VI. REQUEST FOR RELIEF

WHEREFORE, Plaintiff Floyd's 99 Holdings, LLC, requests the following relief:

A. A declaratory judgment that Plaintiff's federally registered trademarks, including the words Floyd's 99, are not likely to cause confusion with Defendant's use of the name Floyd's Barber Shop in Buena Vista, Colorado so as to warrant the cancellation of Plaintiff's Floyd's 99 Marks or to otherwise restrict Plaintiff's use of the Floyd's 99 Marks.

B. A judicial determination that Defendant is barred by the doctrine of laches from enforcing against Plaintiff any right which Defendant may claim to the names Floyd's, Floyd's 99 or other derivations thereof.

C. In the alternative, a declaratory judgment that Plaintiff may concurrently use the Floyd's 99 Marks with Defendant's use of the name Floyd's Barber Shop. Defendant's use of the name Floyd's Barber Shop shall be restricted to the city limits of Buena Vista, Colorado and Plaintiff's use of the Floyd's 99 Marks shall be allowed everywhere except in Buena Vista, Colorado.

D. For an award of attorneys' fees and costs to the extent permitted by law; and

E. For such other relief as the Court deems proper.

PERKINS COIE LLP

s/ Jeffrey J. Cowman
Jeffrey J. Cowman
1899 Wynkoop Street, Suite 700
Denver, CO 80202-1043
Phone: 303.291.2300
Facsimile: 303.291.2400
Email: jcowman@perkinscoie.com
Attorneys for Plaintiff Floyd's 99 Holdings, LLC

Plaintiff's Address:

5340 S. Quebec, Suite 205N
Greenwood Village, Colorado 80111